



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/859,724 | 05/17/2001 | Kristian Pietras | NEX 90 | 2767 |

25871 7590 09/11/2002

SWANSON & BRATSCHUN L.L.C.
1745 SHEA CENTER DRIVE
SUITE 330
HIGHLANDS RANCH, CO 80129

EXAMINER

ZITOMER, STEPHANIE W

ART UNIT PAPER NUMBER

1634

DATE MAILED: 09/11/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/859,724

Applicant(s)

PIETRAS ET AL.

Examiner

Stephanie Zitomer

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Rejections under 35 U.S.C. 112, second paragraph: Indefiniteness

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are confusing in that the recited steps and elements, "treating tumors", "reducing the interstitial pressure", "increasing the uptake of cytotoxic agents", "administering", "host" and PDGF - cytotoxic agent "composition" have no relationship to one another. It is suggested that the claims be rewritten to set forth the functions of the recited elements and how the functions relate to the desired outcome.

Rejection under 35 U.S.C. 102(b): Anticipation

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5, 6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by the patent to Griffin et al. (5,756,291). Griffin et al. disclose a PDGF aptamer and the method of identifying it (column 42, lines 1-5 and 24-44) wherein the aptamer comprises a composition comprising a cytotoxic agent (column 12, lines 45-54) and in therapeutic applications, the aptamer composition is administered to a host (column 38, lines 20-45). The preamble to the claims has not been given weight in rejecting the claims because it is a recitation of future intended use which is inherent in any prior art application and because there is not relationship in the claims between the intended use, the host and the administered composition.

Rejection under 35 U.S.C. 103(a): Obviousness

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

Art Unit: 1634

be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3, 4, 7, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin et al. (5,756,291) as applied to claims 1, 2, 5, 6, 8 and 9 above and further in view of Kondratyev (5,502,037). Regarding claims 3, 7 and 10, drawn to an embodiment wherein the PDGF aptamer is SEQ ID NO:1, it would have been obvious and the skilled practitioner in the art at the time the claimed invention was made would have been motivated to use PDGF aptamers known in the art in the composition and in the administering method of Griffin et al. or to identify new PDGF aptamers employing the method disclosed by Griffin et al. based on preference, available materials and desired results in view of the known characteristics of substantial homology in sequence and similarity of structure, function and target binding affinity in aptamers to the same specific target wherein the selected PDGF aptamers would have been expected to function in the same way as the claimed aptamers absent unexpected results..

Regarding claims 4 and 11, drawn to an embodiment wherein the cytotoxic agent is selected from a group of chemotherapeutic agents known in the art, it would have been obvious and the skilled practitioner in the art would have been motivated at the time the claimed invention was made to use a known chemotherapeutic agent in the PDGF composition of Griffin et al. other than those taught by Griffin et al. based on preference, available materials and cost considerations. Kondratyev is cited as disclosing known cytotoxic agents including those of the claimed invention and those taught by Griffin et al..

Conclusion

4. **No claim is allowed.**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephanie Zitomer whose telephone number is (703) 308-3985. The examiner can normally be reached on Monday through Friday from 9:00 am to 4:30 pm.

Application/Control Number: 09/859,724/NEX90

Page 4

Art Unit: 1634

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152. The official fax phone number for this Group is (703) 308-4242. The unofficial fax number is (703) 308-8724. The examiner's Rightfax number is 703-746-3148.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196. For questions and requests relating to formal matters contact Patent Analyst Tiffany Tabb at 703-605-1238.



Stephanie Zitomer, Ph.D.

September 9, 2002

STEPHANIE W. ZITOMER
PRIMARY EXAMINER